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#13 Appeal
Brief
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John A. Rushing

For: Diffuse Lighting Arrangement

Serial Number: 09/433,761

Filed: 11/04/99

Group Art Unit: 2875

Examiner: A. Ton

Appeal Brief

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For: Diffuse Lighting Arrangement) Group Art Unit: 2875
Serial Number: 09/433,761) Examiner: A. Ton
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Appeal Brief

This is an appeal from the decision of the Primary Examiner, finally rejecting claims 1-9 issued on November 5, 2001, with claim 10 being allowed.

Real Party In Interest

The appellant is the real party in interest.

Related Appeals and Inferences

None

Status of All Claims

An advisory action mailed on February 19, 2002, advised that claims 1-4 have been finally rejected under 35 USC 102(a) as anticipated, claim 5 has been rejected under 35 USC 103, claims 6-9 are rejected under 35 USC 112 second paragraph, and claim 10 has been found allowable.

Status of All Amendments Filed Subsequent to ✓
Final Rejection

An amendment was filed after the issuance of the final rejection and an advisory action was issued by the Examiner refusing to incorporate the Amendment into the application.

Concise Summary of the Invention

The invention comprises a diffuse lighting arrangement including a power cord with a plug at one end thereof, preferably a circuit protection device upstream of the plug, a plurality of parallel connected wire strands of substantially similar length, each of which mounts a plurality of series connected miniature lights thereon. The arrangement is particularly well suited for lighting an outdoor umbrella, with the wire strands each mounting onto one radial rib of the umbrella by adjacent connectors.

The claims of the application read on and are supported by the specification as follows:

1. A diffuse lighting arrangement comprising a main power cord having a plug on one end thereof

arrangement 10...power supply cord 12...plug 14...end 16...
Page 4, lines 5-6

and incorporating a plurality of spaced apart strings of spaced apart miniature lights extending from the power cord

power supply cord 12...strings or wire strands 20...miniature lights 22...
Page 4, lines 10-12

in a parallel configuration when the power cord is horizontally disposed.

power supply cord 12...strings 20 of lights 22...parallel configuration.
Page 4, lines 14-16

2. The arrangement of claim 1 wherein the strings of lights are substantially identical in length.

lights 22...strings 20...equal length.
Page 4, lines 12-13

3. The arrangement of claim 1 wherein the lights on each string are electrically connected in series.

plurality of series connected miniature lights 22...
Page 4, lines 11-12

4. The arrangement of claim 1 wherein each of the light strings electrically connects to the power supply cord in parallel.

power supply cord 12...parallel connected strings or wire strands 20...
Page 4, lines 10-11

5. The arrangement of claim 1 wherein the power supply cord includes a ground fault circuit interrupt.

circuit protection device 18...on the power supply cord 12...
Page 4, lines 7-8

6. The arrangement of claim 1 further including an anchor strap which is adjustable in length.

first end 42...spaced apart holes 46...plurality of nubs 48...snap fit manner.
Page 5, lines 10-12

7. The arrangement of claim 6 wherein the strap has two ends which are engageable to each other about a tubular structure.

the strap 40 comprises an elongate planar member 40...opposite ends 42 and 44...securing the strap 40 about the shaft 30...
Page 5, lines 7-9

8. The arrangement of claim 6 wherein the strap has two elongate edges with a plurality

spaced apart restraints 50...elongate edge 52 of the strap 40

of spaced apart tabs depending from one of the elongate edges.

9. The arrangement of claim 8 wherein a free end of each restraint incorporates structure thereon

which engages a corresponding one of an equal plurality of cooperating engagement structures

which are spaced apart along the anchor strap.

10. For use on a structure including a radial array of support ribs extending from the center thereof,

a diffuse lighting arrangement comprising a power supply cord terminating in a plug

and having a plurality of identical, minimally spaced apart strings of lights extending therefrom,

and an anchor strap engageable at the center of the structure and incorporating a plurality of power supply cord anchoring structures which engage the cord in areas between the spaced apart strings of miniature lights.

Page 5, lines 13-14

one restraint 50 aligning with each of the nubs 48...
Page 5, line 14

free end 54 of each restraint 50...hole 56...over a corresponding nub 48
Page 5, lines 15-16

nubs 48 on the strap 40
Page 5, line 14

strings 20 of lights 22...engaged to support ribs
Page 5, line 21

the arrangement 10...power supply cord 12...plug 14
Page 4, line 5

wire strands 20... miniature lights 22...equal length.
Page 4, lines 11-13

restraints 50...be ensnared
Page 5, lines 18-20

Concise Statement of Issues
Presented for Review

Whether claims 1-4 are anticipated by Adler.

Whether claim 5 is unpatentable over Adler as applied to claim 1 above, and further in view of Lehmann et al.

Whether claim 6-9 as rejected under 35 U.S.C. 112, second paragraph, are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Grouping of Claims for Each
Ground of Rejection Which
Applicant Contests

Grouping of claims as per their individual rejections seems simplist with respect to arguing patentability of same.

Argument

The Examiner first rejects claims 6-9 under 35 USC 112, second paragraph, stating:

"Claim 6 is rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the applicant does not properly recite in the claim how the anchor strap further limits the lighting arrangement. Because of their dependency, claims 7-9 are necessarily rejected."

This rejection is not understood inasmuch as it has not been posed before.

The claims referred to have not been amended and applicant does not understand how the claims have now, at this late date, been found ambiguous.

In this regard, the anchor strap(s) are provided as one possible embodiment for structure used to engage the arrangement to a support structure. It is believed to present a preferred embodiment, but not the only one. Thus, the remark about a gap being present in the structural relationship cannot be found to exist.

Under § 2173.02 it is stated:

"In reviewing a claim for compliance with 35 USC 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claims apprise one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 USC 112, second paragraph."

It is believed that this notice function has been met by claim 6, and hence it and claims 7-9, are not defective under 35 USC § 112, second paragraph.

The Examiner continues the rejection of claims 1-4 under 35 USC 102(e) as anticipated by Adler.

Adler may not be construed to teach minimally spaced apart strings of spaced apart lights extending from a power cord.

At column 2, lines 30-34, Adler describes his lights 18 spaced along the power cord 19, the lights 18 on the power cord 19 being connected in series or parallel.

There is no mention of light strings, or of lights being electrically connected on strings in series, or of such light strings being connected to the power cord in parallel. Such cannot exist because Adler's lights 18 are on the power cord 19, not on strings extending from a power cord.

The Examiner's opinions in this light are not well taken and applicant's demand for strict proof upholding the opinion in the form of an Affidavit has not been provided.

Further, it is noted that the Examiner seems to totally ignore the casing for the lights required in Adler to create his claimed decorative light fixture in the form of an icicle. Leaving out the casing defeats the entire purpose of Adler.

The Mojonner Dawson Company v. U.S. Dairies Sales Corporation et al., 109 USPQ 84 (DC NIII 1955):

"One cannot show anticipation by separating combination into its component elements, and, in light of hindsight, expose them piecemeal as already known to art; however, rule does not come into operation until one has determined that he is dealing with combination rather than aggregation."

In re Papesch, 137 USPQ 43 (CCPA 1963):

"From a standpoint of patent law, a product and all of its properties are inseparable; they are one and the same thing. The patentability of the product does not

depend on the similarity of its structure to that of another product but of the similarity of the former product to the latter. There is no basis in law for ignoring any property in making such a comparison." (emphasis added)

Applicant has no such requirement as he is not creating a decorative light fixture, but rather, a diffuse lighting arrangement as claimed.

Here see In re Sponnoble, 160 USPQ 237 (CCPA 1969):

"Patentable invention, within ambit of 35 U.S.C. 103, may result even if inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond results inherent in their use; it is proper to inquire as to reasons for making the combination; patentable invention may lie in discovery of source of problem even though remedy may be obvious once source of problem is identified; this is part of 'subject matter as a whole' which should always be considered in determining obviousness of an invention under section 103; court must be alert not to read obviousness into an invention on basis of applicant's own statements, i.e., court must view prior art without reading into that art applicant's teachings; issue is whether teachings of prior art would, in and of themselves and without benefits of applicant's disclosure, make invention as a whole, obvious."

With respect to the Examiner's comments regarding no hindsight reconstruction being found, such must necessarily exist without proof to the contrary. Inasmuch as applicant's structure does not exist in Adler, it necessarily follows that the Examiner is attempting to squeeze selected bits of the teachings of Adler into the "mold" applicant provides without considering the teachings of Adler "as a whole" as required by law.

With respect to Adler's "wire 19" (sic) (rather lights 18) being in series or parallel, it is apparent that only applicant connects lights in series to wires connected in parallel to a power cord since Adler's lights are on the power cord 19, eliminating any possibility of teachings strings in parallel.

Thus anticipation cannot be found. Here see the decision in Mendenhall v. Astec Industries, Inc., 13 USPQ2d 1913, 1939 (TN 1988), aff'd, 13 USPQ2d 1956 (Fed. Cir. 1989):

(2) "When a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options

disclosed by the reference, then the reference does not anticipate."

and Ex parte Klotz, 102 USPQ 169 (BdPatApp&Int 1954):

"...it is clear upon inspection that claim 5 as amended contains structural limitations which more definitely distinguish it from the prior art...We do not find this exact teaching in the cited prior art references and since the structural differences over the prior art as set forth in amended claim 5 are productive if a useful result, we think that this claim should be allowed."

and Ex parte Chicago Rawhide Manufacturing Co., 226 USPQ 438 (PTO Bd. App. 1984):

"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not, by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable."

Next, claim 5, dependent on claim 1, is again rejected as obvious from Adler in view of Lehmann, et al.

Lehmann et al may suggest use of a circuit protection device in his small gauge wire string set, however, it cannot be said that such is suggested anywhere for use in applicant's explicitly defined diffuse lighting arrangement.

It would be similar to stating that gears are known so any item including gears would be obvious to create.

Such logic cannot stand on its own.

Here see the decisions in In re Roberts and Burch, 176 USPQ 313 (CCPA 1973):

"A patentable invention, within the ambit of 35 U.S.C. 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use."

and In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984):

"The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification."

and Datascope Corp., v. SMEC, Inc., 776 F.2d 320, 227 USPQ 838 (Fed. Cir. 1985):

"Whether prior art disclosures could physically be substituted in a combination like that claimed in the patent is irrelevant in determining obviousness under Section 103."

and Ex parte Clapp, 227 USPQ 972 (B.P.A.I. 1985):

"Presuming arguendo that the references show the elements or concepts urged, the Examiner presented no line of reasoning as to why the artisan reviewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the Examiner has done little more than cite references to show that one or more elements or some combinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of element. That is to say, the appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. The Board found nothing in the references that would expressly or impliedly teach or suggest the modifications urged by the Examiner. Additionally, the Board found no line of reasoning in the answer as to why the artisan would have found the modifications urged by the Examiner to have been obvious. Based upon the record, the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide."

and King Instrument Corp., v. Otari Corp., 226 USPQ 402 (Fed. Cir. 1985):

"In the absence of evidence that suggests the desirability of combining references in a proposed manner, such combination is not available to preclude patentability under 35 USC 103."

Again, nowhere can the Examiner offer proof of the exact circuit applicant is claiming. Until opinions are set aside and strict proof is presented, requiring applicant to restrict his embodiment to necessarily include an anchor strap is far too restrictive.

Conclusion

Based on the above arguments and extensive case law citations, it is believed this Court will find claims 1-9 allowable over the art cited by the Examiner and will be amenable to granting a Notice of Allowance, overturning the Examiner's rejections.

Respectfully submitted,



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Appendix

1. A diffuse lighting arrangement comprising a main power cord having a plug on one end thereof and incorporating a plurality of spaced apart strings of spaced apart miniature lights extending from the power cord in a parallel configuration when the power cord is horizontally disposed.

2. The arrangement of claim 1 wherein the strings of lights are substantially identical in length.

3. The arrangement of claim 1 wherein the lights on each string are electrically connected in series.

4. The arrangement of claim 1 wherein each of the light strings electrically connects to the power supply cord in parallel.

5. The arrangement of claim 1 wherein the power supply cord includes a ground fault circuit interrupt.

6. The arrangement of claim 1 further including an anchor strap which is adjustable in length.

7. The arrangement of claim 6 wherein the strap has two ends which are engageable to each other about a tubular structure.

8. The arrangement of claim 6 wherein the strap has two elongate edges with a plurality of spaced apart tabs depending from one of the elongate edges.

9. The arrangement of claim 8 wherein a free end of each restraint incorporates structure thereon which engages a corresponding one of an equal plurality of cooperating engagement structures which are spaced apart along the anchor strap.

10. For use on a structure including a radial array of a plurality of support ribs extending from the center thereof, a diffuse lighting arrangement comprising a power supply cord terminating in a plug and having a plurality of identical, minimally spaced apart strings of lights extending therefrom, equal to the plurality of supporting ribs, and an anchor strap engageable at the center of the structure and incorporating a plurality of power supply cord anchoring structures which engage the cord to the center support in areas between the spaced apart strings of miniature lights.

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Certificate Under 37 CFR 1.8(a)

I hereby certify this APPEAL BRIEF is being deposited in triplicate with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 202321, on or before

Date: Aug 5, 02

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